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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,132	02/08/2000	Kiyoshi Iseki	11197/1	2161

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KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/19/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

ab24

# Office Action Summary

Application No.

09/500,132

Applicant(s)

ISEKI ET AL.

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) 5-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2003 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Misiano et al. (5,462,779).

Regarding **claims 1 and 3**, Misiano et al. discloses a functional roll film comprising a transparent plastic film having gas properties (Fig. 1, #10 or Fig. 2, #20), and having an inorganic oxide layer on at least one surface (Fig. 1, #12 or #11, or Fig. 2, #21), wherein the maximum thickness of the inorganic oxide layer is clearly equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer among layer thickness values measured in one roll unit of the plastic film, since the inorganic oxide layer is a completely uniform coating to a

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constant thickness (see col. 2, lines 19-21 and col. 4, lines 26-28). However, Misiano et al. fails to disclose the roll unit containing a film having a width of at least 400 mm and a length of at least 4,000 m and a width of at least 1,000 mm and a length of at least 15,000 m. One of ordinary skill in the art would have recognized the length and width of a packaging film to be sized depending on the object that is being packaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the packaging film of Misiano et al. be sized to having a width of at least 400 mm and a length of at least 4,000 m or a width of at least 1,000 mm and a length of at least 15,000 m, since the size would depend on the object being packaged. Furthermore, it has been held that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding **claim 2**, note the inorganic oxide layer comprises a composite oxide layer having at least two components (Fig. 1, #11 or #12 and Fig. 2, #21), wherein the difference between a maximum wt% and a minimum wt% of one component of the composite oxide in the one roll unit of the plastic film is clearly within 20 wt%, since there is a uniform distribution of the two oxide components throughout its thickness (see col. 2, lines 19-21) and the inorganic oxide layer is a completely uniform coating to a constant thickness (see col. 4, lines 26-28).

4. **Claims 1-3** are rejected under 35 U.S.C. 102(b) as being anticipated by Imai et al. (US 5,378,506).

Regarding **claims 1 and 3**, Imai et al. discloses a functional roll film comprising a transparent plastic film having gas properties (see col. 5, lines 54-61), and having an inorganic oxide layer on at least one surface (see col. 6, lines 36-41), wherein the maximum thickness of the inorganic oxide layer is clearly equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer among layer thickness values measured in one roll unit of the plastic film, since the inorganic oxide layer is a uniform coating (see col. 3, lines 3-6 and col. 5, lines 57-60). However, Imai et al. fails to disclose the roll unit containing a film having a width of at least 400 mm and a length of at least 4,000 m and a width of at least 1,000 mm and a length of at least 15,000 m. One of ordinary skill in the art would have recognized the length and width of a packaging film to be sized depending on the object that is being packaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the packaging film of Imai et al. be sized to having a width of at least 400 mm and a length of at least 4,000 m or a width of at least 1,000 mm and a length of at least 15,000 m, since the size of the film would depend on the object being packaged. Furthermore, it has been held that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding **claim 2**, note the inorganic oxide layer comprises a composite oxide layer having at least two components (see col. 6, lines 40-41), wherein the difference between a maximum wt% and a minimum wt% of one component of the composite oxide in the one roll

unit of the plastic film is clearly within 20 wt%, since the inorganic oxide layer has a uniform thickness (see col. 3, lines 3-6) and is uniform in composition (see col. 4, lines 20-23).

*Response to Arguments*


5. Applicant's arguments filed August 25, 2003 have been fully considered but they are not persuasive. Applicant states that "Misiano does not disclose, either expressly or inherently, a film having a thickness ratio of less than 1.5." However, as shown above in the 103 rejection Misiano clearly teaches a film having a thickness ratio of less than 1.5, since the inorganic oxide layer is a completely uniform coating (see col. 2, lines 19-21 and col. 4, lines 26-28).


*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Catherine Simone  
Examiner  
Art Unit 1772  
November 21, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

11/26/03